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Atty. Dkt. No. WEAT/0173.C1**REMARKS**

This is intended as a full and complete response to the Final Office Action dated January 21, 2005, having a shortened statutory period for response set to expire on April 21, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 22-30, 46-50 remain pending in the application after entry of this response. Claims 22-25 and 46-48 have been amended. No new matter has been added by the amendments. Claims 22-30 and 46-50 are rejected by the Examiner. Reconsideration of the rejected claims is requested for reasons presented below.

Applicants would like to thank the Examiner for taking the time to speak with Applicants' representative on March 17, 2005 via telephone. In the interview, Applicants' representative pointed out the distinctions argued with respect to claim 46, below. The Examiner preliminarily acknowledged these distinctions and stated that he would consider them in more detail upon submission of this response.

**Claim Objections**

Claims 47 and 48 are objected to because of the recitation of "the path" in claim 47 is indefinite because it is not clear whether the flow path or the signal path is being referred to and the recitation of "wherein downhole device" in claim 48 should most likely be --wherein the downhole device--. Claims 47 and 48 have been amended to overcome the objections. Withdrawal of the objections is respectfully requested.

**Claim Rejections Under 35 USC § 102**

Claims 46-48, 22 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,367,565 to *Hall*. Applicants respectfully traverse the rejection.

*Hall* does not teach, suggest, or disclose a method, comprising "positioning a tubular string in a wellbore, the tubular string including: a signal transducing downhole device; and an axially extendable signal conducting tool ... located between the downhole device and an upper end of the tubular string; and sending a signal between

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the downhole device and a location above the signal conducting tool, the signal traversing a path through the signal conducting tool,” as recited in claim 46.

In the rejection, the Examiner cites the hammer 21 of *Hall* as corresponding to the axially extendable signal conducting tool and the drill bit 23 as corresponding to the downhole device of claim 46. Respectfully, the hammer 21 is axially movable, not axially extendable. The hammer 21 is depicted as a single piece and movement of the hammer 21 is completely internal with respect to *Hall's* overall device, thus movement of the hammer 21 does not result in an increase in length of the overall device. If the Examiner modifies the rejection to characterize the overall device (including the drill bit 23) as the axially extendable signal conducting tool, then *Hall* discloses nothing that corresponds to the signal transducing downhole device where the axially extendable signal conducting tool is located between the downhole device and an upper end of the tubular string. It then follows that *Hall* cannot teach the act of sending the signal between the downhole device and a location above the signal conducting tool. Further, the signal in *Hall's* device originates at the transducer 22 located at an upper end of the drill bit 23. If *Hall's* overall device corresponds to the axially extendable signal conducting tool, then the signal would only travel through a portion of *Hall's* overall device. Therefore, claim 46 is patentable over *Hall*. Claims 47, 48, 22, and 27 are also patentable over *Hall* since they depend from claim 46.

Regarding claim 22 on its own merit, *Hall* does not teach, suggest, or disclose a method, comprising “transmitting a signal from at least one sensor located below the tool and adjacent to the downhole device”. In the rejection, the Examiner cites the transducer 22 of *Hall's* device as corresponding to the sensor of claim 22. As discussed above, the hammer 21 is not axially extendable, there is no downhole device, and the transducer 22 is located at an upper end of the drill bit 23, thus *Hall* does not disclose a sensor located below the tool and adjacent to the downhole device. It then follows that *Hall* cannot disclose the act of transmitting a signal from the sensor. Therefore, claim 22 is patentable over *Hall*.

Regarding claim 47 on its own merit, *Hall* does not teach, suggest, or disclose a method, comprising sending a signal between the downhole device and a location above the signal conducting tool, “wherein the signal path includes a wall of the signal

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conducting tool". In the rejection, the Examiner cites, from *Hall*, the hammer 21 as corresponding to the signal conducting tool and the throat 24 as corresponding to the wall of the tool. The throat 24 is not a wall of hammer 21. The throat 24 has no mechanical interaction with hammer 21. As may be viewed from Figs. 6, 7 and 8, 9 of *Hall*, the throat 24 remains stationary while the hammer 21 moves freely relative to the throat and does not mechanically interact with this movement. Therefore, claim 47 is patentable over *Hall*.

**Claim Rejections Under 35 USC § 103**

Claims 49, 50, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hall* in view of U.S. Patent 4,899,834 to *Weldon*. As discussed above, *Hall* does not teach, suggest, or disclose the act of sending a signal between the downhole device and a location above the tool, wherein the signal traverses through the tool. *Weldon* does not teach, suggest, or disclose act of sending a signal between the downhole device and a location above the tool, wherein the signal traverses through the tool. Therefore, claim 46 is patentable over *Hall* in view of *Weldon*. Claims 49, 50, 29 and 30 are also patentable over *Hall* in view of *Weldon* since they depend from claim 46.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hall* in view of U.S. Patent 4,416,494 to *Watkins*. As discussed above, *Hall* does not teach, suggest, or disclose the act of sending a signal between the downhole device and a location above the tool, wherein the signal traverses through the tool. *Watkins* does not teach, suggest, or disclose act of sending a signal between the downhole device and a location above the tool, wherein the signal traverses through the tool. Therefore, claim 46 is patentable over *Hall* in view of *Watkins*. Claims 23-25 are also patentable over *Hall* in view of *Watkins* since they depend from claim 46.

Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hall* in view of U.S. Patent 6,296,066 to *Terry*. As discussed above, *Hall* does not teach, suggest, or disclose the act of sending a signal between the downhole device and a location above the tool, wherein the signal traverses through the tool. *Terry* does not teach, suggest, or disclose act of sending a signal between the downhole device

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and a location above the tool, wherein the signal traverses through the tool. Therefore, claim 46 is patentable over *Hall* in view of *Terry*. Claims 26 and 28 are also patentable over *Hall* in view of *Terry* since they depend from claim 46.

### **Conclusion**

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the Final Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Final Office Action.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

  
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